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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,155	11/25/2003	Theodore R. Sana	10030511-1	8586

7590 06/27/2006
AGILENT TECHNOLOGIES, INC.
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Intellectual Property Administration
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EXAMINER

KIM, YOUNG J

ART UNIT PAPER NUMBER

1637

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/722,155	SANA ET AL.	
	Examiner	Art Unit	
	Young J. Kim	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a method of synthesizing a plurality of biopolymers, wherein one or more of said biopolymers are degenerate biopolymers, classified in class 536, subclass 25.3.
- II. Claim 10, drawn to an array of biopolymers, wherein at least one of said biopolymers comprises degenerate biopolymers, classified in class 536, subclass 24.33.
- III. Claims 11 and 12, drawn to a method of detecting a target nucleic acid with an array comprising degenerate biopolymers, classified in class 435, subclass 6.
- IV. Claims 13 and 26, drawn to a data set, which is an assay result, classified in class 702, subclass 20.
- V. Claims 14-16, drawn to a method of transmitting data, classified in class 716, subclass 12.
- VI. Claims 17-22, drawn to a method of synthesizing a plurality of oligonucleotides on a substrate, wherein the oligonucleotides are phylogenetically related, classified in class 536, subclass 25.3.
- VII. Claim 23, drawn to an array of oligonucleotides comprising oligonucleotides, wherein said array comprises phylogenetically related oligonucleotides, classified in class 536, subclass 24.33.
- VIII. Claims 24 and 25, drawn to a method of detecting phylogenetically related target nucleic acid, classified in class 435, subclass 6.

Art Unit: 1637

- IX. Claims 27-30, drawn to a method of synthesizing an array of oligonucleotides and its apparatus, classified in class 536, subclass 25.3.
- X. Claims 31 and 32, drawn to a method for normalizing the results of binding reactions involving a plurality of samples and plurality of arrays, classified in class 702, subclass 104.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III, IV, V, VI, and VIII-X are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06).

The method of synthesizing a plurality of degenerate biopolymers embodied by Group I is patentably distinct from the method of Group VI which embodies a method of synthesizing a plurality of phylogenetically related oligonucleotides, by virtue of their (oligonucleotides) structures. The methods of Group I and VI are unrelated to methods of Groups III, V, VIII, and X as the steps are totally different and unrelated. The methods of Groups III, V, VIII, and X, similarly, are unrelated to each other as involving totally different steps and achieving unrelated outcomes (e.g., detecting target nucleic acids, transmitting data, synthesizing a generic array by drop deposition, and normalizing an assay result).

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the array of II can be made by a materially different process, such as photolithography, capillary deposition, etc.

Inventions I and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions the method of Group I cannot and does not result in the array of Group VII.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the array of Group II can be used in a materially different process, such as examining differential expression of genes.

Invention II is unrelated to Inventions III-X. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the array of Group II is not required by the inventions of Groups III-X.

Inventions III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the method of Group III cannot be achieved by the array of Group VII.

Inventions IV and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the data of Group IV is structurally and characteristically different from the array of Group VII.

Art Unit: 1637

Inventions V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions the method of transmitting data embodied by Group V does not require the array of Group VII.

Inventions VI and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the array of Group VII can be made by a materially different process, such as photolithography, capillary deposition, etc.

Inventions VII and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the array of Group VII can be used in a materially different process, such as examining differential expression of genes.

Invention VII is unrelated to Inventions IX-X. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, method of synthesizing an array embodied by Group IX does not result in the array of Group VII nor does the method of normalizing embodied by Group X require the array of Group VII.

Art Unit: 1637

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was not made to request an oral election to the above restriction requirement due to the complex nature of the requirement (MPEP § 812.01).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Inquiries

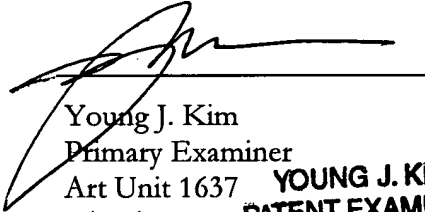
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 8:30 a.m. to 4:30 p.m. The Examiner can also

Art Unit: 1637

be reached via e-mail to Young.Kim@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.



Young J. Kim
Primary Examiner
Art Unit 1637
6/26/2006

**YOUNG J. KIM
PATENT EXAMINER**

yjk